



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,813	12/20/1999	MASATOSHI KUMAGAI	PM265486	1620

909 7590 12/19/2002
PILLSBURY WINTHROP, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

BLAIR, DOUGLAS B

ART UNIT	PAPER NUMBER
----------	--------------

2142

DATE MAILED: 12/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/466,813

Applicant(s)

KUMAGAI ET AL.

Examiner

Douglas B Blair

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Claims 1-24 are pending in this application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-4, 10-13, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,449,657 to Stanbach Jr. et al..

5. As to claim 1, Stanbach teaches an SMTP server sending a mail having a predetermined mail address as a recipient to a server that receives and manages the mail having the predetermined mail address (col. 9, lines 26-42), comprising: an advertisement information memory operable to store advertisement information to be added to the mail (col. 11, lines 63-67 and col. 12, lines 1-16); an advertisement information detector operable to detect the

Art Unit: 2142

advertisement information to be added to the mail from the advertisement information memory based on at least one of user information about a user having the mail address of the recipient of the mail, user information about a user having mail address of the mail, user information about a user having a mail address of a sender of the mail and a sentence included in the mail (col. 10, lines 15-39); an advertisement information adding portion operable to add the advertisement information to the mail (col. 14, lines 31-47); and a sending portion operable to send the mail to the server (col. 10, lines 64-67 and col. 11, lines 1-10).

6. As to claim 2, Stanbach teaches the SMTP server of claim 2, wherein the advertisement information includes page-specifying information that specifies a predetermined homepage (col. 14, lines 30-47).

7. As to claim 3, Stanbach teaches the SMTP server of claim 2, wherein the user information includes attribute information that indicates an attribute of the user, a user information memory is further provided to be operable to store a plurality of mail addresses and a plurality of pieces of attribute information about users for the plurality of mail addresses so as to be associated with each other, respectively (col. 10, lines 64-67 and col. 11, lines 1-22), and the advertisement information memory stores the advertisement information and attribute information about a user who is an object for which addition of said advertisement information is performed so as to be associated with each other (col. 11, lines 11-34), the advertisement information detector detects the attribute information associated with the mail address of the recipient of the mail from the user information memory (col. 11, lines 11-22), and detects the advertisement information associated with said detected attributed information from the advertisement memory (col. 11, lines 11-50).

Art Unit: 2142

8. As to claim 4, Stanbach teaches the SMTP server of claim 3, wherein the attribute information is at least one of age, gender and a zip code (col. 12, lines 17-39).

9. As to claims 10-13, Stanbach's invention could be embodied as a POP server (col. 9, lines 26-42). All other limitations from claims 10-13 are rejected on the same basis as claims 1-6.

10. As to claim 18, its limitations are featured in claim 1, thus it is rejected on the same basis as claim 1.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 5-9 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,449,657 to Stanbach, Jr. et al. in view of U.S. Patent Number 6,360,221 to Gough et al..

13. As to claim 5, Stanbach teaches the SMTP server of claim 4, however Stanbach does not teach an advertisement refusal system.

Gough teaches a mail system comprising: an addition refusal information memory, operable to store addition refusal information specifying a mail address that refuses the addition of the advertisement; and an addition controller operable to stop the addition of the advertisement information by the advertisement information adding portion to the mail, in a case

Art Unit: 2142

where the mail address specified by the addition refusal information is the mail address of the recipient of the mail (col. 6, lines 12-39).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Stanbach regarding a email advertisement system with the teachings of Gough regarding an advertisement refusal option because such a service could be profitable (Gough col. 6, lines 12-39).

14. As to claim 6, Stanbach teaches the SMTP server of claim 5, further comprising a target key word memory, operable to store the advertisement information and a key word to be included in a sentence of a mail to which said advertisement information is added, so as to be associated with each other (col. 11, lines 23-34), wherein the advertisement information detector detects advertisement information that is associated with a key word corresponding to a phrase included in a sentence of the mail to be sent (col. 11, lines 23-34).

15. As to claim 7, Stanbach teaches a the SMTP server of claim 6, including a key word memory operable to the advertisement information and a key word to be included in a sentence of a mail to which said advertisement information is added; however, Stanbach does not explicitly teach the removal of advertisement information based on the presence of a keyword.

Stanbach teaches the removal of advertisement information from a mail passed on the presence of demographic information in an email (col. 14, lines 48-67 and col. 15, lines 1-12).

It would have been obvious to one of ordinary skill in the computer Networking art at the time of the invention to combine the teachings of Stanbach regarding the use of keywords with the teachings of Stanbach regarding the removal of advertisement information because certain

Art Unit: 2142

advertisers may not want advertisements added to emails with certain words (col. 14, lines 48-67 and col. 15, lines 1-12).

16. As to claim 8, Stanbach teaches an SMTP server wherein the mail has plurality of mail addresses of recipients, the sending portion sends the mail to each of the mail addresses of the recipients when the mail has the plurality of mail addresses of the recipients (col. 10, lines 64-67 and col. 11, lines 1-22), the advertisement information detector detects the advertisement information to be added to the mail that is to be sent to each of the mail addresses (col. 11, lines 11-34), based on the attribute information of the user corresponding to each of the mail addresses (col. 11, lines 11-22), and the advertisement information to the mail that is sent to each of the mail addresses of the recipients (col. 11, lines 11-50).

17. As to claim 9, Stanbach teaches an SMTP server comprising: a point information memory operable to store a mail address and point information for a user having said mail address to be associated with each other; and a point updating portion operable to update the point information associated with the mail address of the sender of the mail, when the advertisement information adding portion adds the mail to the advertisement information (col. 14, lines 48-62).

18. As to claims 14-17, Stanbach's invention could be embodied as a POP server (col. 9, lines 26-42). All other limitations from claims 14-17 are rejected on the same basis as claims 5-9.

19. Claims 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,449,657 to Stanbach, Jr. et al. in view of U.S. Patent Number 6,360,221 to Gough et al. and U.S. Patent Number 6,014,502 to Moraes.

Art Unit: 2142

20. As to claim 19, Stanbach teaches a mail processing system comprising a mail server operable to send a mail having a recipient mail address of an intended recipient to a server that receives and stores the mail, wherein the mail server includes: an advertisement information memory operable to detect advertisement information to be added to the mail from the advertisement information memory based on at least one of: (a) user information about a user having recipient mail address, (b) user information about a user having a sender mail address corresponding to a sender of the mail, and (c) a portion of a message in the mail: an advertisement information adding portion operable to add the advertisement information to the mail (col. 11, lines 63-67 and col. 12, lines 1-16); and a sending portion operable to send the mail to the server, wherein the web server includes: a reception portion operable to receive an adding request of advertisement information to the mail from the terminal (col. 10, lines 64-67 and col. 11, lines 1-10); however Stanbach does not explicitly teach a client program for requesting the addition of advertisement information to emails, a web server including a reception portion operable to send the mail to the server, or a web server operable to send a predetermined program to a terminal based on a request from the terminal.

Gough teaches a program on a terminal, from which the adding request is received, so that the mail, which is to be sent to the recipient mail address from the terminal, is sent to the mail server that adds the advertisement and a web server including a reception portion operable to receive an adding request of advertisement information to the mail from the terminal (col. 4, lines 1-21, The user requests that "enhancements" be added to the mail at the server.).

Moreas teaches a web server operable to send a predetermined program to a terminal based on a request from the terminal (col. 10, lines 44-64).

Art Unit: 2142

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Stanbach regarding a system for inserting advertisements in an email at a server with the teachings of Gough regarding the requesting that a server make additions to email at a server because requesting that information be added to an email increases the enjoyment of email experiences (Gough col. 1, lines 53-67 and col. 2, lines 1-5). It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Stanbach regarding a system for inserting advertisements in an email at a server with the teachings of Moreas regarding a server carrying out a request for a program from a terminal because sending a program to a user facilitates the use of an email advertisement system (Moreas col. 10, lines 37-42).

21. As to claim 20, Stanbach teaches a mail processing system, wherein the advertisement information adding portion of the mail server adds to the mail, advertisement information including user specifying information that specifies a user of the mail, address of the recipient of the mail, and link information that makes the terminal used by the user send the user specifying information to the web server when an instruction by the user occurs (col. 14, lines 48-62), the web server or the mail server includes a point information memory operable to a mail address, and point information of a memory operable to a mail address, and point information of a user having said mail address to be associated with each other (col. 10, lines 64-67 and col. 11, lines 1-10), the web server further includes: a user specifying information receiving portion operable to receive the user specifying information sent from the terminal by the link information sent from the terminal by the link information; and a point updating portion operable to update, based

Art Unit: 2142

on the user specifying information received by the user specifying information receiving portion, the point information of the corresponding user (col. 10, lines 64-67 and col. 11, lines 1-10).

22. As to claim 21, Stanbach teaches a mail processing system wherein the advertisement information adding portion in the mail server adds to the mail advertisement, specifying information that specifies an advertiser of the advertisement information, and link information that makes a terminal used by the user having the mail address of the recipient of the mail send the advertisement specifying information to the web server when an instruction of said user occurs (col. 10, lines 64-67 and col. 11, lines 1-10), the web server or the mail server includes a charging information memory operable to store information specifying an advertiser and charging information about charging on said advertiser (col. 14, lines 63-67 and col. 15, lines 1-12), the web server further includes: an advertisement specifying information receiving portion operable to receive the advertisement specifying information sent from the terminal by the link information (col. 10, lines 64-67 and col. 11, lines 1-10); and a charging information updating portion operable to update based on the advertisement specifying information received by the advertisement specifying information receiving portion, the charging information of a corresponding advertiser (col. 14, lines 63-67 and col. 15, lines 1-12).

23. As to claim 22, Stanbach teaches a mail processing system wherein the web server or the mail server includes a charging information memory operable to store advertisement specifying information that specifies an advertiser, charging information about charging on said advertiser (col. 14, lines 63-67 and col. 15, lines 1-12), and address information of an advertisement homepage to be presented to a user of a terminal, so as to be associated with one another, the advertisement information adding portion adds to the mail advertisement, specifying information

Art Unit: 2142

that specifies an advertiser of the advertisement information (col. 14, lines 30-47), and link information that makes the terminal send the advertisement specifying information to the web server in a case where an instruction of the user of the terminal occurs, the web server includes: an advertisement specifying information receiving portion operable to receive the advertisement specifying information sent from the terminal by the link information (col. 10, lines 64-67 and col. 11, lines 1-10); an instruction information memory controller operable to control the terminal that sent the advertisement specifying information, to store instruction information indicating that an instruction by the user occurred (col. 10, lines 64-67 and col. 11, lines 1-10); and a homepage retrieval controller operable to detect, based on the advertisement specifying information received by the advertisement specifying information receiving portion, the address information of the advertisement homepage associated with the advertisement specifying information and to control the terminal to retrieve the advertisement homepage having said address information (col. 14, lines 30-47).

24. As to claim 23, Moreas teaches a confirmation receiving portion operable to receive confirmation that the instruction information is stored in a terminal that requested a pre-determined target homepage that is linked to the advertisement homepage (col. 6, lines 41-65); and a goal achievement charging updating portion operable to update, based on receipt of the confirmation, the charging information associated with an advertisement specifying information of an advertiser of the target homepage indicated by the confirmation (col. 6, lines 41-65).

25. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,360,221 to Gough et al. in view of U.S. Patent Number 6,014,502 to Moraes.

Art Unit: 2142

26. As to claim 24, Gough teaches a method for enabling a terminal to send mail, comprising: receiving a request to add advertisement information to a mail from the terminal by a web server and a program in the terminal for enabling the terminal to send a recipient addressed mail to a mail server that adds advertisement information to the mail (col. 4, lines 1-21, The user requests that "enhancements" be added to the mail at the server.); however Gough does not explicitly teach sending a program to a terminal and installing that program.

Moreas teaches sending an email program to a terminal and installing that program (col. 10, lines 44-64).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Gough regarding the requesting that a server make additions to email at a server with the teachings of Moreas regarding a server carrying out a request for a program from a terminal because sending a program to a user facilitates the use of an email advertisement system (Moreas col. 10, lines 37-42).

27. Claims 1-5, 10-14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,360,221 to Gough et al. in view of U.S. Patent Number 6,047,310 to Kamakura et al. and U.S. Patent Number 6,073,165 to Narasimhan et al..

28. As to claim 1, Gough teaches a server sending a mail having a predetermined mail address as a recipient to a server that receives and manages the mail having the predetermined mail address (col. 4, lines 1-21), comprising: an advertisement information adding portion operable to add the advertisement information to the mail (col. 7, lines 25-42); and a sending portion operable to send the mail to a user (col. 5, lines 28-39); however, Gough does not

Art Unit: 2142

explicitly teach an advertisement information memory, an advertisement information detector, or the use of an SMTP server.

Kamakura teaches an advertisement information memory operable to store advertisement information to be added to the mail (col. 6, lines 13-36) and an advertisement information detector operable to detect the advertisement information to be added to a mail from the advertisement information memory based on at least one of user information about a user having the mail address of the recipient of the mail, user information about a user having a mail address of a sender of the mail and a sentence included in the mail (col. 4, lines 35-57).

Narasimhan teaches the use of an SMTP server in a mail content filtering system (col. 3, lines 10-20).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Gough regarding the addition of advertisements to electronic mail messages with the teachings of Kamakura regarding the use of information to user information to filter advertisements because both teach an email advertising system and a filtering mechanism could be added to Gough's embodiment without changing the functionality of the invention. It would have been further obvious to combine the teachings of Narasimhan regarding the use of an SMTP server with the teachings of both Gough and Kamakura because the use of an SMTP server would not alter the functionality of the previously discussed email advertising systems.

29. As to claim 2, Gough teaches a server wherein the advertisement information includes a page specifying information that specifies a predetermined homepage (col. 18, lines 40-43).

Art Unit: 2142

30. As to claim 3, Kamakura teaches a server wherein the user information includes attribute information that indicates an attribute of the user, a user information memory is further provided to be operable to store a plurality of mail addresses and a plurality of pieces of attribute information about users for the plurality of mail addresses so as to be associated with each other (Figure 11 shows a table that contains addresses and attributes.), respectively, and the advertisement information memory stores the advertisement information and attribute information about a user who is an object for which addition of said advertisement information is performed so as to be associated with each other, the advertisement information detector detects the attribute information associated with the mail address of the recipient of the mail from the user information memory, and detects the advertisement information associated with said detected attributed information from the advertisement memory (Figure 14 shows the processes used to distribute the advertisement.).

31. As to claim 4, Kamakura teaches a server wherein the attribute information is at least one of age, gender, and a zip code (col. 4, lines 49-57).

32. As to claim 5, Gough teaches a server comprising an addition refusal information memory, operable to store addition refusal information specifying a mail address that refuses the addition of the advertisement and an addition controller operable to stop the addition of the advertisement information by the advertisement information adding a portion to the mail, in a case where the mail address specified by the addition refusal information is the mail address of the recipient of the mail (col. 6, lines 12-39).

As to claim 5, Gough teaches a server comprising an addition refusal information memory, operable to store addition refusal information specifying a mail address that refuses the addition

Art Unit: 2142

of the advertisement and an addition controller operable to stop the addition of the advertisement information by the advertisement information adding a portion to the mail, in a case where the mail address specified by the addition refusal information is the mail address of the recipient of the mail (col. 6, lines 12-39).

12. As to claim 10, Gough teaches a server sending a mail having a predetermined mail address as a recipient to a server that receives and manages the mail having the predetermined mail address (col. 4, lines 1-21), comprising: a mail memory operable to store the mail having the predetermined mail address as the recipient (col. 6, lines 12-39); an advertisement information adding portion operable to add the advertisement information to the mail (col. 7, lines 25-42); and a sending portion operable to send the mail to a user (col. 5, lines 28-39); however, Gough does not explicitly teach an advertisement information memory, an advertisement information detector, or the use of an POP server.

Kamakura teaches an advertisement information memory operable to store advertisement information to be added to the mail (col. 6, lines 13-36) and an advertisement information detector operable to detect the advertisement information to be added to a mail from the advertisement information memory based on at least one of user information about a user having the mail address of the recipient of the mail, user information about a user having a mail address of a sender of the mail and a sentence included in the mail (col. 4, lines 35-57).

Narasimhan teaches the use of a POP server in a mail content filtering system (col. 3, lines 10-20).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Gough regarding the addition of

Art Unit: 2142

advertisements to electronic mail messages with the teachings of Kamakura regarding the use of information to user information to filter advertisements because both teach an email advertising system and a filtering mechanism could be added to Gough's embodiment without changing the functionality of the invention. It would have been further obvious to combine the teachings of Narasimhan regarding the use of a POP server with the teachings of both Gough and Kamakura because the use of a POP server would not alter the functionality of the previously discussed email advertising systems.

33. As to claims 11-14, they have similar limitations to claims 2-5, respectively and are thus rejected on the same basis as claims 2-5.

34. As to claim 18, its limitations are featured in claim 1, thus it is rejected on the same basis as claim 1.

35. Claims 6-9 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,360,221 to Gough et al. in view of U.S. Patent Number 6,047,310 to Kamakura et al. and U.S. Patent Number 6,073,165 to Narasimhan et al. as applied to claim 5 above, and further in view of U.S. Patent Number 6,128,646 to Miloslavsky.

36. As to claim 6, the teachings of Gough, Kamakura, and Narasimhan combine to make the matter of claim 5 obvious; however, Gough, Kamakura, and Narasimhan do not explicitly mention the use of key words for filtering advertisements.

Miloslavsky teaches the idea of parsing emails in order to search for specific keywords and performing an action based on those keywords (col. 4, lines 11-64).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Gough, Kamakura, and Narasimhan regarding

Art Unit: 2142

a server for sending advertisements in email with the teachings of Miloslovsky regarding filtering based on keywords because sending advertisements based on keywords would provide more relevant advertisements for consumers.

37. As to claim 7, Miloslovsky teaches the idea of parsing emails in order to search for specific keywords and performing an action based on those keywords (col. 4, lines 11-64).

38. As to claim 8, Kamakura teaches a server wherein the mail has a plurality of mail addresses of recipients, the sending portion sends the mail to each of the mail addresses of the recipients when the mail has the plurality of mail addresses of the recipients (Figure 22), the advertisements information detector detects the advertisement information to be added to the mail that is to be sent to each of the mail addresses, based on the attribute information of the user corresponding to each of the mail addresses (col. 4, lines 35-57), and the advertisement information adding portion adds the advertisement information to the mail that is sent to each of the mail addresses of the recipients (Figure 21).

39. As to claim 9, Gough teaches a server comprising a point information memory operable to store a mail address and point information for a user having said mail address to be associated with each other; and a point updating portion operable to update the point information associated with the mail address of the sender of the mail, when the advertisement information adding portion adds the mail to the advertisement information (col. 15, lines 23-47).

40. As to claims 15-17, they have similar limitations to claims 6-9, respectively, and are thus rejected on the same basis as claims 6-9.

Response to Arguments

41. Applicant's arguments filed 11/12/2002 have been fully considered but they are not persuasive. The applicant argues the following points: (a) Moraes et al. provide no description of adding an advertisement to a mail message which is to be sent from a sender to a recipient; (b) Moraes et al. do not disclose installing a program in a terminal for enabling the terminal to send a mail message, which is to be sent to a recipient mail address; (c) The idea of adding advertisement information to the mail, which is to be sent to the recipient from the sender, is not disclosed in Gough et al.; (d) Kamakura does not teach or even suggest "an advertisement information detector"; (e) Miloslavsky clearly does not disclose "the use of keywords for filtering advertisement" as suggested by the Examiner; and (f) The resulting arrangement of the combination of Gough et al., Kamakura et al., and Moraes that would be created by one of ordinary skill in the art would be different from those defined by our claims which embody the idea of adding advertisement information appropriate for the individual characteristics of the sender or recipient, to one specific mail.

42. As to point (a), Moraes discloses displaying advertisements to a user while the user is reading an email message (col. 5, lines 25-31).

43. As to point (b), The invention of Moraes is an email client. The user installs the client (col. 11, lines 38-44) and then uses the client for email (col. 12, lines 59-61).

44. As to point (c), Gough teaches the idea of adding advertisements to mail from a sender to a recipient. The user of Gough's system selects "enhancements" to be added to the mail (col. 4, lines 1-21). Figure 2 shows that these enhancements could be advertisements (Note the Amazon and Disney enhancements.).

Art Unit: 2142

45. As to point (d), In col. 4, lines 35-57, Kamakura describes a system that examines or detects attributes and based on those attributes adds an advertisement to an email message.

46. As to point (e), Miloslavsky teaches a method of using keywords to filter emails to certain people. For reasons discussed in the above rejection it would be obvious to combine this filtering with advertising.

47. As to point (f), This argument is considered moot in view of new grounds of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B Blair whose telephone number is 703-305-5267. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Powell can be reached on 703-305-9703. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.

Douglas Blair
December 16, 2002


MARK POWELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100